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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,864	08/04/2003	Gordon John Kocur	10177-219-999	5627

20583 7590 04/01/2005

JONES DAY  
222 EAST 41ST ST  
NEW YORK, NY 10017

EXAMINER
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FISCHER, JUSTIN R

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**Application No. **BN**

10/633,864

Applicant(s)

KOCUR ET AL.

Examiner

Justin R. Fischer

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1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8403,22505.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 6,752,829. Although the conflicting claims are not identical, they are not patentably distinct from each other; the claims in the current application are fully encompassed by the claims in '829.

Regarding claim 1, claim 29 of '829 discloses a method of making a stent prosthesis comprising the steps of covering a tube or mandrel with a stent covering material (analogous to channel material of claimed invention), forming a channel by exposing said covering material to a treatment selected from the group consisting of heat treatment, chemical treatment, and treatment with an adhesive. In this instance, claim 1 of the current application is generic to the method of claim 29 of '829 (fully encompassed by claims of '829).

As to claims 2-4, the disclosed means of attachment would have been obvious to one of ordinary skill in the art at the time of the invention as they are consistent with the common attachments means in the industry. It is particularly noted that claims 14 and 15 expressly suggest the claims attachment means. Also, one of ordinary skill in the art at the time of the invention would have recognized that the "attachment to the sidewall" disclosed by '829 is in relation to the struts as they define the exterior surface of the sidewall.

Regarding claims 5 and 12, claim 16 of '829 suggests that the channel/strut assembly is covered by a covering material.

As to claim 6, claim 33 of '829 discloses a method in which the tube or mandrel is removed and biologically active material is introduced into said channel.

Regarding claims 7 and 8, claim 29 of '892 generically suggests that the channel is attached to the sidewall (defined by plurality of struts). The claim, however, does not identify the steps as being in sequential order and as such, one of ordinary skill in the art at the time of the invention would have found it obvious to incorporate the biologically active material or remove the tube or mandrel prior to attaching said channel to the sidewall. It is further noted that the language "obtaining the stent covered by a layer of a stent covering material" in claim 28 of '892 is not seen to suggest that the attachment of the channel to the sidewall occurs prior to the steps disclosed in (b)-(d). Thus, the method of '892 does not exclude the formation of the channel via the treatments disclosed above and the subsequent attachment of the channel to the sidewall.

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With respect to claim 9, claim 35 of '892 describes an injection technique.

Regarding claims 10 and 13, claim 38 of '892 suggests that the stent covering material (analogous to channel material of the claimed invention) is selected from the group comprising silicones and polyurethanes.

With respect to claim 11, as previously noted, claims 13 and 14 of '892 disclose the attachment of the channel to the struts via fusion and the subsequent weaving technique in order to form the sidewall of the stent.

### ***Conclusion***

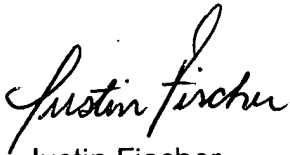
3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Banas (US 6,004,348), Sogard (US 6,139,573), and Khosravi (US 6,793,672) disclose prosthetic stent assemblies that are similar in nature the stent construction of the claimed invention.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Justin Fischer". The signature is written in a cursive, flowing style.

Justin Fischer

March 29, 2005